

Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

02-IMP-037

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 25, 2007

Signature

*Christine Gillroy*

Typed or printed name Christine Gillroy

Application Number

10/669,186

Filed

September 24, 2003

First Named Inventor

Victor M. Benveniste

Art Unit

2881

Examiner

David Vanore

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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attorney or agent of record.  
Registration number 36,981

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

*Thomas G. Eschweiler*

Signature

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Typed or printed name

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Telephone number

January 25, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. EATNP139US

02-IMP-037

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re **PATENT** application of:

Applicant: Benveniste

Serial No.: 10/669,186

For: ION BEAM SLIT EXTRACTION WITH MASS SEPARATION

Filing Date: September 24, 2003

Examiner: David Vanore

Art Unit: 2881

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

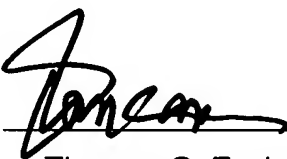
Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Favorable reconsideration of the above-identified application is respectfully requested in view of the following remarks.

Should it be deemed that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, an invitation to contact the undersigned at the telephone number provided below is hereby extended.

Should any fees be due as a result of this filing, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, EATNP139US.

Respectfully submitted,  
ESCHWEILER & ASSOCIATES, LLC

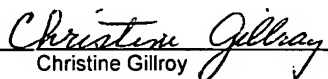
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Date January 25, 2007

  
Christine Gillroy

Claims 1-17 and 21-29 are pending in this application. Claims 1, 4-7, 8-13, 15-17, 21, 23 and 25-29 were rejected under Section 103 over Benveniste (USPN 5,554,857). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Benveniste discloses ***electromagnets having coils*** that are configured to provide *adjustable magnetic fields*, whereas the inventions set forth in independent claims 1, 21 and 29 provide ***permanent magnets*** for dipole magnetic field generation. The Office Action admits the deficiency of Benveniste, but avers that it would have been obvious to one of ordinary skill in the art to modify Benveniste in accordance with the claimed invention. Applicant respectfully disagrees.

Modifying a prior art reference is appropriate when one of ordinary skill in the art would have been motivated to do so. Such motivation may be found in the nature of the problem to be solved, in the teachings of the prior art, or in the general knowledge of persons of ordinary skill in the art. MPEP § 2143.01 (I) (*citing In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998)). However, ***if a proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*** MPEP § 2143.01 (V) (*citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). It is respectfully submitted that the proposed modification would render the Benveniste reference unsatisfactory for its intended purpose for at least the following reasons.

Benveniste is directed to an ion implantation system that employs a mass analyzer having primary coils for creation of a dipole magnetic field. (See, e.g., Col. 2, lines 35-40). ***The selection of electromagnets employing coils in the prior art reference is not arbitrary, but instead is employed for the express purpose of flexibility.*** For example, the reference explicitly states the following:

The strength of both the quadrapole and dipole fields are adjusted by a controller electrically coupled to the primary and additional current carrying coils of said magnet.

A magnet constructed in accordance with the invention adds flexibility to the implanter. This flexibility allows the implanter to be used with different species ions at low energy implant levels. (Col. 2, lines 47-53).

Therefore Benveniste uses electromagnets for the express purpose of flexibility; so that when changing dopant species that have a different mass-energy product, the same system may be used by simply adjusting the dipole magnetic field strength *via* the current in the primary coils. Consequently, a modification of Benveniste to employ permanent magnets in accordance with the claimed invention would render Benveniste unsatisfactory for its intended purpose. Consequently one of ordinary skill in the art would not be motivated to do so. Therefore claims 1, 21 and 29 are non-obvious over the cited art.

The claims remaining in this application depend from independent claims 1, 21 or 29 and are thus also allowable over Benveniste, where the other references previously cited do not make up for the deficiencies of Benveniste. Withdrawal of this rejection is therefore respectfully requested.